

REMARKS/ARGUMENTS

It is stated in the Office Action that the application claims groups of inventions that are not so limited to form a general concept under PCT Rule 13.1. Set forth in the Office Action are eight groups of inventions (Groups I through VIII) which are said to be "exemplary". It is expressly acknowledged in the Office Action that the eight groups are not exhaustive.

Applicants are offered the alternative, instead of electing one of the eight groups expressly set forth, to elect a specific compound and "Examiner will attempt to group it". Applicants choose to take the latter course of action, i.e., to elect a compound not encompassed in any of the compound claims of the eight groups. Applicants hereby provisionally elect the compound of Example 1, i.e., 3-(1H-Indol-3-yl)-4-[6-(4-methyl-piperazin-1-yl)-3-trifluoromethyl-pyridin-2-yl]-pyrrole-2,5-dione. Applicants make this election with traverse. To be clear, the traverse is as the restriction is applied to the compound claims (Groups I-VI) the restriction among composition claims (I-VI), method of preparation (Group VII) and method of use (Group VIII) is not traversed.

Applicants submit that it is improper for the Patent Office to set forth a restriction requirement that is merely "exemplary". Applicants are entitled to know the full scope of the restriction requirement before being requested to make an election. The "non-exemplary" undefined groups can have a significant bearing on the group chosen for election. Indeed, in the present provisional election, Applicants want to include Example 1, which is not even encompassed by any of the compound claims in the eight groups set forth in the Office Action. Furthermore, Applicants are mystified by the alternative offered by the Examiner, i.e., to elect a single compound and the "Examiner will attempt to group it". Looking at group I, for instance, the "Group" is a single species. If the Examiner follows this pattern, the elected "Group" will be a single species, i.e., the provisionally elected compound of Example 1. Such a restriction group containing only a single species is manifestly unfair, is in direct conflict with the PCT rules of unity of invention and is contrary to Patent Office practices and procedures. Annex B, Unity of Invention, of the PCT rules clearly sets forth the requirements of a generic compound claim under "Markush Practice" to meet the unity of invention standard. These requirements are that 1.) all the alternatives have a common property or activity and 2.) a common, significant structural element is shared by all of the alternatives. Applicants claims 1-5 (Group I-VI), and the undefined "groups" not encompassed by I-VI, clearly meet both of the PCT requirements in order for unity of invention to exist.

It is submitted that the reasons set forth in the Office Action at the bottom of page 5 of the Office Action regarding U.S. patent number 5,057,614 are irrelevant. The cited Example 87

of the,'614 patent bears no relevance whatsoever for unity of invention. Nowhere is it even remotely suggested by the PCT rules that the common structure must "define a contribution over the prior art" in order to meet the unity of invention requirement.

Applicants request that the restriction requirement as it applies to the compound claims be withdrawn and that claims 1-5 be examined on the merits.

Respectfully submitted,

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